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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91197573
Party	Defendant Sipi Metals Corp.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

CHASE BRASS, LLC, a Delaware Limited
Liability Company,

Opposer,

v.

SIPI METALS CORP., an Illinois Corporation,

Applicant.

Marks: ECO BRONZE / ECO-BRONZE /
ECOBRONZE

Opposing Marks: ECO BRASS / ECOBRASS

Opposition No. 91/197,571

Opposition No. 91/197,573

Opposition No. 91/197,574

MOTION TO DISMISS AND FOR A MORE DEFINITE STATEMENT

Sipi Metals, Corp. (“Sipi Metals”) (“Applicant”)¹, by and through its attorneys, hereby moves the Trademark Trial and Appeal Board (the “Board”) for an order to dismiss the Section 2(a) and 43(c) grounds for opposition pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure (Fed.R.Civ.P.), and Section 503 of the Trademark Trial and Appeal Board Manual of Procedure (TBMP), and for a more definite statement as to the Section 2(d) ground pursuant to Fed. R. Civ. P. 12(e) and TBMP § 505. As this motion is not dispositive, Applicant concurrently files in good faith an Answer and a Counter-Claim for Invalidity of the cited marks. Suspension pending the determination of this dual motion may be required by the Board in its discretion to make sure the pleading phase is conducted in the best manner. 37 C.F.R. § 2.127(d); T.B.M.P. § 510.

¹ Applicant moved in a concurrent motion filed therewith for consolidation of (a) Opposition No. 91/197,571, (b) Opposition No. 91/197,573, and (c) Opposition No. 91/197,574.

Motion to Dismiss Grounds 2(a) and 43(c) Under Fed. R. Civ. P. 12(b)(6)

This Board must dismiss claims in a notice of opposition for failure to state a claim if “plaintiff can prove no set of facts in support of his claim which would entitle him to relief.” *Advanced Cardiovascular Sys. V. SciMed Life Sys.*, 988 F.2d 1157 (Fed. Cir. 1993). When ruling on a motion to dismiss, although the Board must accept the factual allegations pleaded in the complaint as true, *Abbott Labs. v. Brennan*, 952 F.2d 1346, 1354 (Fed. Cir. 1991), “[c]onclusory allegations of law and unwarranted inferences of fact do not suffice to support a claim.” *Bradley v. Chiron Corp.*, 136 F.3d 1317, 1322 (Fed. Cir. 1998).

A. 15 U.S.C. § 1052(a): False Suggestion of a Connection

Section 2(a) of the Lanham Act provides in part: “No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it – (a) Consists of or comprises... matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”

Paragraph 8 of the notice of opposition is the only part that may relate to a 2(a) claim of false association. It provides in part: “The mark sought to be registered by Applicant... is likely to... lead the public and prospective purchasers to believe that applicant’s goods are those of Sambo and/or Chase or are endorsed, sponsored, or otherwise affiliated or connected with Sambo and/or Chase...”

In *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), the Court of Appeals for the Federal Circuit stated that in order to succeed on a Section 2(a) false suggestion of a connection claim, the plaintiff must demonstrate that the name or equivalent thereof claimed to be appropriated by another is unmistakably associated with a particular personality or “persona” and must point uniquely to

the plaintiff. (emphasis added). This Board in *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985), required that a plaintiff asserting a claim of a false suggestion of a connection demonstrate and plead: 1) that the defendant's mark is the same or a close approximation of plaintiff's previously used name or identity; 2) that the mark would be recognized as such; 3) that the plaintiff is not connected with the activities performed by the defendant under the mark; and 4) that the plaintiff's name or identity is of sufficient fame or reputation that when the defendant's mark is used on its goods or services, a connection with the plaintiff would be presumed. See also *In re Sloppy Joe's International Inc.*, 43 USPQ2d 1350 (TTAB 1997); and *In re Kayser-Roth Corp.*, 29 USPQ2d 1379 (TTAB 1993).

A mark must have a close approximation with a name or an identity. *In re Shinnecock Smoke Shop*, Serial 78/918,061 (the mark "SHINNECOCK BRAND, FULL FLAVOR" for cigarettes is in connection with the Shinnecock tribe); *In re Hsieh*, Serial 78/367,205 (the mark P.MAURIAT for musical instruments falsely suggested an association with the famous musician Paul Mauriat); *In re G&R Brands, LLC*, Serial 77/011,920 (the mark MOHAVE for tobacco products is associated with the Fort Mojave Indian Tribe of Arizona). Here Opposer does not plead that ECO BRONZE / ECO-BRONZE / ECOBRONZE has any connection with a name or an identity, much less the identity of Opposer.

As recently as last month, in an Opposition (*Carr v. Garnes*, Opposition 91/171,220), this Board wrote "[I]n inter partes proceedings before the Board, an essential element of a Section 2(a) claim of false suggestion of a connection is that the defendant's mark must point uniquely and unmistakably to the identity or persona of the "person" or "institution" asserting the claim. If the defendant's mark does not point uniquely and unmistakably to the plaintiff's identity or persona, then there can be no false suggestion of a connection." *Internet Inc. v. Corporation for*

National Research Initiatives, 38 USPQ2d 1435, 1436 (TTAB 1996). Even if all facts of the notice of opposition are construed as true, the pleading or any associated fact simply fails to support any Section 2(a) claim. Therefore, under Rule 12(b)(6), this Board must dismiss the Section 2(a) claim from the notice of opposition.

B. 15 U.S.C. § 1125(c)(1): Dilution [Section 43(c)]

Opposer in the notice of opposition briefly and superficially addresses a possible dilution claim at paragraph 9:

9. The grant of a registration to Applicant for its mark as sought in the '614 Application should be denied on the grounds that Applicant's use and registration of ECOBRONZE dilutes the distinctiveness of the ECO BRASS mark, which is famous.

Opposer is a licensee of Sambo Copper Allow Co., Ltd. ("Sambo"), and not the owner of the mark. (See Caption of Notice of Opposition). No facts are given in support of the claim of fame. The Court of Appeals for the Third Circuit wrote: "To establish a prima facie claim for relief under the Federal Dilution Act of 1995, 15 U.S.C. § 1125(c)(1), the plaintiff must plead and prove: 1) The plaintiff is the owner of a mark that qualifies as a "famous" mark in light of the totality of the eight factors listed in § 1125(c)(a); 2) The defendant is making commercial use in interstate commerce of a mark or trade name; 3) Defendant's use began after the plaintiff's mark became famous, and 4) Defendant's use causes dilution by lessening the capacity of the plaintiff's mark to identify and distinguish goods or services." *Times Mirror Magazines, Inc. v. Las Vegas Sports News, LLC*, 212 F.3d 157, 54 USPQ2d (BNA) 1577 (3rd Cir. 2000).

1. Opposer is Not the Owner and Lacks Standing

Section 43(c)(1) of the Lanham Act is known as the Federal Trademark Dilution Revision Act of 2006 (FTDRA), and provides that "the owner of a famous mark" is entitled to an injunction against another person's use in commerce. The use of the term "owner" appears to

prohibit a licensee from maintaining an action under Section 43(c). *Standing and Joinder Consideration in Trademark Litigation and Licenses*, INTA Vol. 99, No. 6, page 1445, by Kim J. Landsman, Daniel C. Glazer, and Irene C. Treloar. Distributors under an exclusive license, even if given the exclusive right to use the mark in the territory, the exclusive right to sue for trademark infringement, and an unconditional right to transfer or assign the rights in the trademarks, lack standing under the FTDR. *ICEE Distributors, Inc. v. J & J Snack Foods Corp.*, 325 F.3d 586 (5th Cir. 2003). If the Board was to allow a licensee to Oppose on Section 43(c), the Board would be placed in a position to determine and rule on the fame of a mark without the owner present. Such a finding may be greatly prejudicial to the owner. The Section 43(c) ground must be dismissed under Rule 12(b)(6) for lack of Standing as the owner is missing and is an indispensable party to this ground for opposition.²

2. Fame is Improperly Plead as a Conclusory Allegation

Opposer at paragraph 9 of the notice makes a conclusory allegation that Licensor's mark is famous. Not a scintilla of evidence is given. "Conclusory allegations of law and unwarranted inferences of fact do not suffice to support a claim." *Bradley v. Chiron Corp.*, 136 F.3d 1317, 1322 (Fed. Cir. 1998). The pleading, while notice based, must still include more than conclusory allegations. Section 15 U.S.C. § 1125(c)(2)(A) provides that "a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." If the Opposer wants to claim fame in a niche market or

² Sambo, the trademark owner, is absent from this action and qualifies as a "necessary party" under Rule 19(a) of the Federal Rules of Civil Procedure. Once Applicant is successful in this action against Chase, either Sambo or any other licensee of Sambo of the marks can petition to Cancel Applicant's marks leaving Applicant at a substantial risk of incurring double, multiple, or otherwise inconsistent obligations by reason of the claimed interest. The Sambo Copper Allow Co., Ltd. filed and was granted two requests for extension of time to oppose by this Board under 37 C.F.R. § 2.102 but has waived its right to oppose by not joining this action to oppose. By waiving the right, the necessary party has become indispensable and dismissal of the action pursuant to Rule 19(b) is required.

claim that the general consumer is a great consumer of bars and alloys, then this must be plead so it may be dismissed on summary judgment. Absent such facts in the notice, the claim must be dismissed under Rule 12(b)(6) for failing to state a claim for which relief can be granted.

3. No Interstate Commerce Use is Plead

The pleading must include a statement that the mark is in use in interstate commerce. The notice of opposition is silent as to any use in interstate commerce. Paragraph 4 only states that, “Chase used and continues to use ECO BRASS for copper alloy in rods for use in, among other things, manufacturing by machining, casting and forging.” The pleading is greatly deficient. Opposer asserts it is given authority to use ECOBRASS and ECO BRASS, yet is silent as to what mark is in use, what the use is, or if the use is in interstate commerce. For example, if Opposer has a license to ECOBRASS and ECO BRASS but only uses one mark in interstate commerce, only one mark can be asserted under the 43(c) ground, thus limiting the issues in the case. Absent such facts in the notice, the claim must be dismissed under Rule 12(b)(6) for failing to state a claim for which relief can be granted.

4. No Use in Interstate Commerce is Plead

The pleading must include a claim that use by Applicant began after the plaintiff’s mark became famous. Opposer simply claims at paragraph 9 that its mark is famous. It fails to provide guidance as to when such fame was obtained. The pleading must include a statement as to when mark ECOBBRASS acquired fame, in what market, and a showing of the fame that predates Applicant’s use. Once again, the pleading under Section 43(c) is improper and must be dismissed for failure to state a claim on which relief may be granted. Therefore the Section 43(c) must be dismissed under Rule 12(b)(6) for failing to state a claim on which relief can be granted.

5. The Pleading is Silent as to Dilution Facts

The pleading must give notice as to how the existence of ECO BRONZE / ECO-BRONZE / ECOBRONZE in the market causes dilution of Opposer's marks ECOBRASS or ECO BRASS. It is unclear what Opposer implies by claiming that ECO BRONZE dilutes ECO BRASS. Does Opposer own any mark with "eco" as part of the name, marks with a metal as part of the mark, or a combination of both?

In Texas, an Applicant is approved for registration for the mark ECO CHROME for metal shelving in International Class 6 (Application 77/459,884). A Cedar Rapids corporation is approved for registration for the mark ECOCOPPER for copper and copper alloy in International Class 6 (Application 77/486,062). In Wheeling, Illinois, an Applicant was approved in 2010 for the mark ECO-ALUMINUM for aluminum foil and aluminum foil paper in International Class 6 (Application 77/859,311, now abandoned) and ECO-ALUMINUM WRAP for the same goods (Application 77/859,080).

At this moment, a rapid investigation of the trademark registry shows hundreds of other "eco" based marks in International Class 6. For example, another Japanese corporation (aside from Sambo) is approved for the mark ECO SOLDER for lead and lead alloys for use in welding in International Class 6 (Application 77/364,617). A German Registrant owns the mark ECOPROTECT for common metals and their alloys, including copper-based alloys (Registration No. 3,892,729). Wire mesh is sold under ECO MESH & Design (Registration No. 3,846,427). Nails are sold under the ECO-NAILS mark (Registration No. 3,851,424). Steel tube is sold under the ECO-POLE mark (Registration No. 3,776,022). (TARR Reports and Certificates of Registrations attached as Exhibit A).

In 2006, Sambo filed for the mark ECOCAST for copper and copper alloys based on a claim of priority of Japanese Application No. 2005-020162. Application No. 78/598,821 was abandoned on February 13, 2006. Sambo currently does not own any other “eco” based marks or any mark with the word “bronze.” Opposer simply makes a conclusory statement that its mark is famous and that the marks are diluted. Such a statement falls below the minimum “short and plain statement” requirement for notice pleading. “Short and plain statement” must be reasonably definite. What constitutes “short and plain statement” must be determined by type of case, relief sought, situation of parties, and whether it is desirable in obtaining speedy justice that plaintiff state with particularity his alleged claim. *Fleming v Dierks Lumber & Coal Co.*, 39 F Supp 237 (1941, DC Ark).

A complaint was dismissed by a California Court in 2006 stating: “Plaintiffs’ claim did not contain short and plain statement of claim showing that they were entitled to relief, as required by *Fed. R. Civ. P. 8(a)*, when they merely asserted that defendants’ intended use of their marks would constitute trademark infringement and dilution, without any factual allegations concerning nature of threatened use; because plaintiffs had not given defendants fair notice of claims against them and had not shown by alleged facts that plaintiffs were entitled to relief, they had merely provided conclusory allegations and their complaints were subject to dismissal under *Fed. R. Civ. P. 12(b)(6)*.” *Dow Jones & Co. v Int’l Sec. Exch., Inc.* 451 F3d 295, 79 USPQ2d 1225 (2006, CA2 NY). The Notice gives no information as to who sells what, if the mark is used in interstate commerce, or how and when fame was acquired. Clearly in this context, a failure to provide any fact in the notice as to why dilution is conceived is fatal to the count under Section 43(c). Therefore the Section 43(c) must be dismissed under Rule 12(b)(6) for failing to state a claim on which relief can be granted.

Motion to Define 2(d) Ground Under TBMP § 505

In the notice of opposition, only Section 2(d) appears to have some vague, albeit brief coherence. The Section 2(d) Ground has many flaws for which a motion for a more definite statement under TBMP § 505 is likely to be the adequate remedy. When a pleading is so vague or ambiguous that a party cannot reasonably be required to frame a responsive pleading, the responding party may move for a more definite statement to be included on any amended pleading. TBMP § 505.

At paragraphs 2 & 3 of the Notice of Opposition, Opposer attaches two certificates of Registrations for the marks ECOBRASS and ECO BRASS (Registration Nos. 2,474,958 & 2,479,029 respectively) owned by Sambo. ECOBRASS is registered for copper alloy in bars, billets and sheets in International Class 6. ECO BRASS is registered for copper alloy in the nature of brass in bars, billets and sheets. Opposer asserts that while it is licensee of both of these marks, it uses ECO BRASS. (See Paragraphs 5-6 of the notice). At Paragraph 5, Opposer pleads it uses its mark ECO BRASS for copper alloy in rods and not for the goods of either Registration No. 2,474,958, or Registration No. 2,479,029. This is, at best, vague and confusing and must be clarified.

To succeed on a 2(d) claim, a pleading must assert that Applicant's mark so resembles a cited mark as to be likely, when applied to the goods and/or services of the cited mark in the marketplace, to cause confusion. TBMP § 309.03(c)(B). Here, Chase may be claiming rights over the certificates or some common law use, each with a different priority date. This is poor and vague drafting for which this Board should request a more definite statement and therefore grant this motion for a more definite statement on the 2(d) ground.

The following confusing statement is plead: "Chase's use of ECO BRASS long predates the filing date of the '614 Application..." Because of the vagueness of the pleading, it is

impossible to know if Chase claims that the sale of rods predates the '614 Application or if the sale of brass bars covered by the certificate predates the '614 Application. Opposer must clarify the 2(d) ground or it must be dismissed by this Board either for failing to meet TBMP § 505 or if this Board finds the entire ground must be replead based on Rule 12(b)(6). Therefore, Applicant moves for a more definite statement as to the 2(d) ground or alternatively for dismissal under Rule 12(b)(6).

Conclusion

Three different corporations requested and were granted several extensions of time to oppose by this Board. Ultimately, only Chase opposed. Three grounds for opposition were asserted, 2(a), 2(d), and 43(c). Opposer does not understand that 2(a), unlike 2(d) is a ground to be asserted against marks capable of pointing back to Opposer and that have “identity” or “persona.” ECO BRONZE, ECO-BRONZE, or ECOBRONZE are incapable of pointing to Opposer and the 2(a) claim must be dismissed under 12(b)(6). The dilution claim is no different and fails because of at least five different reasons, the most obvious being that Opposer as a licensee has no standing to file this ground. Therefore, the 43(c) claim must also be dismissed under 12(b)(6).

Finally, notice pleading must at a minimum give notice to Applicants of what right is asserted. In the notice, different marks, with different goods, owned by different parties, and with different priority dates are given. No use in commerce is described. The 2(d) claim is at best unclear, vague, and requires clarification before discovery starts. The right tool to correct the vagueness and lack of support of the notice is a motion for a more definite statement or the dismissal under 12(b)(6). Applicant respectfully requests that the Board strike from the pleading any claim as to Opposition on Sections 2(a) and 43(c) and either request from Opposer a more

definite statement as to the Section 2(d) ground or dismiss the notice altogether as it is improperly plead and missing an indispensable party (the owner) to this Opposition.

An order to this effect will greatly focus the discovery and lead to efficient judicial resolution.

Respectfully submitted,

SIPI METALS CORP.

/Robert S. Beiser/
Robert S. Beiser

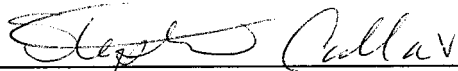
Dated: January 3, 2011

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CERTIFICATE OF SERVICE

I hereby certify that on the 3rd day of January 2011, I served a true and correct copy of the foregoing **Motion to Dismiss and for a More Definite Statement** on the attorney for the Petitioner at the address indicated below by depositing said document in the United States mail, first class postage prepaid:

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